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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

08/478,114 06/07/95 POENISCH P 6605-9

GRAYBILL EXAMINER

A1M1/0802

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| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1107

DATE MAILED: 08/02/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/478,114

Applicant(s)

Poensch et al.

Examiner

David E. Graybill

Group Art Unit

1107



☒ Responsive to communication(s) filed on 23 Apr 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-54 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-54 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, ^{SUBSTITUTE} PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, ^{SUBSTITUTE} PTO-948

☐ Notice of Informal Patent Application, PTO-152 ¹

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, claims 1-31 and 49-54, drawn to a process, classified in class 437, subclass 183.

Group II, claims 32-48, drawn to a product, classified in class 257, subclass 778.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case, the process as claimed can be used to make another and materially different product such as a die having no bronzing agent formed on the barrier layer (additional process steps can be performed to eliminate the bronzing agent before the barrier layer with the bronzing agent formed thereon is formed on the die).

Because these inventions are distinct for the reasons given supra and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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A telephone call was made to Michael E. Fogarty on 31 July 1996 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to the group receptionist at (703) 308-0661.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday; 8:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, supervisory primary examiner, John Niebling, can be reached at (703) 308-3325.

The fax phone number for group 1100 is (703) 305-3599.


David E. Graybill
Patent Examiner
Art Unit 1107

D.G.
31 July 1996